

REMARKS

The Examiner is thanked for indicating that claims 3, 7, 10, 13-15, 21, 25, 28, and 37-38 would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims.

Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 3, 7, 10, 13-15, 21, 25, 28, and 37-38 have been rewritten in independent form including all of the limitations of the respective base claims and any intervening claims. Consistent with 35 U.S.C. 112, paragraph 4, the rewritten claims comprise exactly the same subject matter, and therefore scope, as previously presented. Thus, no narrowing of these claims has occurred.

Claims 1, 2, 4-6, 8-9, 11-12, 16-20, 22-24, 26-27, and 29-36 have been cancelled without prejudice or disclaimer, for resubmission in a future continuation application. Claims 3, 7, 10, 13-15, 21, 25, 28, and 37-38 are now pending in this application. Claims 3, 7, 10, 13, 15, 21, 25, 28, and 37 are the independent claims.

I. The Anticipation Rejection

The Office Action (dated 29 March 2004) indicates that claims 3, 7, 10, 13-15, 21, 25, 28, and 37-38 would be allowable if written in independent form including all of the limitations of the base claim and any intervening claims. Applicant complies with that condition in this Reply. The Office Action also rejects claims 1-38, however, as anticipated under 35 U.S.C. §102(e). In support of the rejection, Solomon (U.S. Patent No. 5,974,043) was cited. This rejection is respectfully traversed to the extent that it does not represent a typographical error.

Solomon fails to establish a prima facie case of anticipation. See MPEP 2131. To anticipate expressly, the “invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art

reference, arranged as in the claim”. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001). The single reference must describe the claimed subject matter “with sufficient clarity and detail to establish that the subject matter existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention”. *Crown Operations Int’l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (C.C.P.A. 1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354 (Fed. Cir. Jan. 6, 2003) (“A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.”)

The Office Action recites that the “[p]rior art of record fails to explicitly disclose in combination with the limitations of the independent claims, wherein the first network is the internet or wherein the first device is a vehicle navigation system and wherein the complementary data includes navigational video data delivered to the first device and supplementary data delivered to the second device wherein the first device is a video monitor and wherein the complementary data includes video data delivered to the first device and subtitles delivered to the second device.” *See* § 5 pages 8-9.

Further, independent claims 3, 7, 10, 13, 15, and 37, from which claims 14 and 38 depend, recite “synchronously delivering **complementary data**”. Independent claims 21, 25, and 28 depend, recites “forming **complementary data**”.

As explained at MPEP 2111.01, the words of a claim must be given their plain meaning **unless** they are defined in the specification. Here, the claim term “**complementary data**” clearly has been defined in the specification, and that definition must control examination of those claims that recite these terms. Specifically, page 3 of the present Application explicitly defines “**complementary data**” as:

at least two streams of related data that are semantically related to each other such that, when combined, form an organic whole. For example, the audio data and the video data for a television program may be considered to be complementary data.

At col. 19, lines 32-36, Solomon allegedly recites that “[t]he exchanged information can be any type of digital information such as compressed **or** non-compressed voice information, compressed **or** noncompressed video information **or** data files containing any other type of digital information”.

Thus, Solomon does not teach expressly or inherently either “delivering” or “forming” “**complementary data**” as that term is clearly defined in the present application. Accordingly, it is respectfully submitted that the rejection of claims 1, 12, 19, and 30 is unsupported by Solomon and should be withdrawn. Also, the rejection of claims 2, 4-6, 8-9, 11, 16-18, 20, 22-24, 26-27, 29, and 31-36, each ultimately depending from one of independent claims 1, 12, 19, and 30, is unsupported by Solomon and also should be withdrawn.

II. The Obviousness Rejection

Claims 10, 28, 30-36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Solomon (U.S. Patent No. 5,974,043) in view of Kim (U.S. Patent No. 6,317,425). The Office Action also indicated that claims 10 and 28 would be allowable if written in independent form including all of the limitations of the base claim and any intervening claims. These rejections are respectfully traversed to the extent that the rejection of claims 10 and 28 was not a typographical error .

None of the cited references, either alone or in any combination, establish a *prima facie* case of obviousness. “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally,

the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." See MPEP § 2143.

Independent claim 10 recites "synchronously delivering complementary **data**". Independent claim 28 recites "forming **complementary data**". Solomon does not expressly or inherently teach or suggest either "delivering" or "forming" "**complementary data**". Kim does not overcome the deficiencies of Solomon.

Thus, even if there were motivation or suggestion to combine Solomon with Kim to arrive at the claimed subject matter (an assumption with which the applicant disagrees), and even if Solomon and Kim were combinable or modifiable (another assumption with which the applicant disagrees), the cited references do not expressly or inherently teach or suggest **every** limitation of the independent claims.

Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted.

Consequently, reconsideration and withdrawal of the rejection of claims 10 and 28 is respectfully requested.

CONCLUSION


It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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Date: 25 June 2004

A handwritten signature in black ink, appearing to be "Michael N. Haynes", is written over a horizontal line.

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